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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,412	01/21/2004	Clive S. Lu	LU-016	1205

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WELSH & FLAXMAN LLC  
2450 CRYSTAL DRIVE  
SUITE 112  
ARLINGTON, VA 22202

EXAMINER
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BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

10/760,412

Applicant(s)

LU, CLIVE S.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 14, 15 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 14-15 and 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak in view of 2002-52480 and Erokhin.

Novak discloses a grip for a golf club (Title) having a transparent [0007] polymeric [0020] body (30) having an inner surface and an outer surface (Fig. 4), a grip being substantially cylindrical in the form of the bore [0019], and inner surface defining a cavity shaped and dimensioned for receiving an article (Fig. 3) and a design in the form of an insert (Figs. 1,5) which can be seen through the transparent body (Fig. 1) for printing, design, color and emblem purposes [0022].

Novak lacks a three dimensional design formed within a transparent body and between the inner surface and the outer surface of the body wherein the design is a result of altering the appearance and material characteristics of the body between the inner and outer surface. 2002-5480 discloses a grip having a design pattern formed within a transparent body and being three dimensional (Figs. 1,3, Title DERWENT). Erokhin discloses creating laser-induced images (title) within three-dimension by

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altering the material characteristics of a (Col. 3, Lns. 7-10) transparent polymer material (Col. 5, Lns. 31-38) in order to provide decoration (Col. 1, Lns. 35-36). In view of the patent of 2002-52480 and Erokhin it would have been obvious to modify the grip of Novak to have a three dimensional design formed within a body and between the inner surface and the outer surface of a body wherein the design is a result of altering the appearance and material characteristics of the body between the inner and outer surface in order to provide a three dimensional design or emblem for indication and decorative purposes visually pleasing to a golfer.

3. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruana in view of Novak, 2002-52480 and Erokhin.

Ruana discloses a grip for hand held apparatuses (Col. 1, Lns. 19-23) being substantially cylindrical (Fig. 13) where the material is a polymer in the form of polyurethane or rubber or any other material which could act as a covering to a hand support system (Col. 4, Lns. 49-54) having an inner surface and an outer surface, an inner surface defining a cavity shaped and dimensioned for receiving an article (Figs. 9-10, 12), a design on an outer surface (Col. 8, Lns. 61-67), a light source coupled to a grip for directing light onto a design, and a LED (Fig. 13, Col. 8 Ln. 61 through Col. 9, Lns. 14), a light emitting means within a grip (Col. 8, Lns. 61-63) and an independent battery source (Col. 9, Lns. 5-8).

Ruana lacks a transparent polymeric body, a design within a body and between an inner and outer surface of the body, a design being three dimensional, a grip for a golf club, and a first end being closed.

Novak discloses grip material being transparent [0007] polymeric [0020], a grip for a golf club (Title), a first end being closed (Fig. 3) and a design in the form of an insert (Figs. 1,5) which can be seen through the transparent body (Fig. 1) for printing, design, color and emblem purposes [0022]. In view of the publication of Novak it would have been obvious to modify the grip of Ruana to have a transparent polymeric body in order to maximize the light emitting from the light source. In view of the publication of Novak it would have been obvious to modify the grip of Ruana to have a grip for a golf club, and a first end being closed in order to provide light emitting and enhance graphics on hand held apparatus of a grip of a golf club for example when used at night or for entertainment purposes.

2002-5480 discloses a hand grip having a design pattern formed within a transparent body and being three dimensional (Figs. 1,3, Title DERWENT). Erokhin discloses creating laser-induced images (title) within three-dimension by altering the material characteristics of a (Col. 3, Lns. 7-10) transparent polymer material (Col. 5, Lns. 31-38) in order to provide decoration (Col. 1, Lns. 35-36). In view of the patent of 2002-52480 and Erokhin it would have been obvious to modify the grip of Ruana to have a transparent polymeric body and a design within a body and between an inner and outer surface of the body in order to provide a three dimensional design or emblem

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for indication and decorative purposes visually pleasing to a grip user which is lighted for a grip.

4. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruana in view of Novak, 2002-52480 and Erokhin as applied to claims 18-23 above, and further in view of VanderSchuit.

Ruana lacks a light source positioned within a cap coupled to a body.

Novak discloses a cap coupled to a body (Fig. 3). In view of the publication of Novak it would have been obvious to modify the grip of Ruana to have a cap coupled to a body in order to prevent the grip from slipping down a shaft when in use.

VanderSchuit discloses LEDs and batteries positioned within elastic bodies ([0104], [0048], and Figs. 9-10) as handles (Fig. 12) which are being illuminated. In view of the publication of VanderSchuit it would have been obvious to modify the grip of Ruana to have a light source positioned within a cap of a grip and within other places of a grip in order to simplify the assembly process of a grip onto a shaft by only have to slip on a pre-manufactured grip onto a shaft without having to place an light emitter on and than a grip over the light emitter.

### ***Response to Arguments***

5. The argument the reference of Erokhin is improper since Erokhin does not disclose applying technology to a grip disclosed by Novak or the '480 patent is

disagreed with. The '480 patent clearly discloses having three dimensional designs in handles and Novak discloses designs for polymer golf grips. The technology of Erokhin is for transparent material which Novak's grip is. The argument that the patent of '480 is improper due to not having an inner surface is disagreed with. '480 was not used for this but Novak was. '480 was used to show that it is known to have three dimensional designs in handles.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Liou discloses a light emitting ball for playing a round of golf at night.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 11 June 2005



**STEPHEN BLAU**  
**PRIMARY EXAMINER**